REMARKS

The following remarks are responsive to the August 31, 2005 Office Action. Claims 1-19 and 21-30 are presented for further consideration. Please reconsider the claims in view of the following remarks.

Response to Rejection of Claims 1-12, 19, and 22-30 Under 35 U.S.C. § 103(a)

In the August 31, 2005 Office Action, the Examiner rejects Claims 1-12, 19, and 22-30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,002,394 issued to Schein et al. ("Schein") in view of U.S. Patent No. 6,430,359 issued to Yuen et al. ("Yuen").

Claim 1

As previously presented, independent Claim 1 recites (emphasis added):

> 1. A digital video recorder connectable to a set-top box configured to receive electronic program guide information and broadcast audiovisual data, the set-top box including at least one auxiliary interface that supports communication between the digital video recorder and the set-top box, the digital video recorder comprising:
>
> at least one recorder interface connectable to the auxiliary interface;
>
> a storage device;
>
> a microprocessor configured to control the digital video recorder and the set-top box, **the microprocessor comprising an electronic program guide subsystem connected to the recorder interface to receive the electronic program guide information from the set-top box** and to process the electronic program guide information to schedule recording the broadcast audiovisual data on the storage device; and
>
> a video output interface separate from the recorder interface, the video output interface connectable to a display device.

Thus, Claim 1 recites that the microprocessor comprises "an electronic program guide subsystem" and "receive[s] the electronic program guide information **from the set-top box**" (emphasis added).

Claim limitations missing from both cited references

Applicants submit that the combination of Schein and Yuen does not disclose or suggest a microprocessor "comprising an electronic program guide subsystem connected to the recorder interface to receive the electronic program guide information from the set-top box," as recited by Claim 1. Schein discloses a microprocessor in a computer which receives EPG information and which can be located within a set-top box. (See, e.g., Schein at col. 4, lines 56-57.) As

acknowledged by the Examiner, Schein does not disclose placing the microprocessor in the digital video recorder.

Applicants submit that Yuen does not disclose or suggest the limitations of Claim 1 which are not disclosed or suggested by Schein. Yuen discloses a G-code decoding microprocessor which can be placed in a video cassette recorder, or in other components of a video system. (See, e.g., Yuen at Figures 1, 3, and 32-35.) However the G-code decoder disclosed by Yuen does not "receive the electronic program guide information from the set-top box," as recited by Claim 1. As disclosed by Yuen, the G-code decoder receives a G-code and simply decodes it into channel, date, time, and length (CDTL) information (see, e.g., Yuen at col. 6, line 64 – col. 7, line 2). Yuen further discloses that rather than entering the CDTL information to record a program, the user provides the G-code corresponding to a selected program to the G-code decoder (see, e.g., Yuen at col. 6, lines 7-11). Thus, Yuen does not disclose or suggest a microprocessor in a digital video recorder which receives EPG information from the set-top box, as recited by Claim 1.

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974); M.P.E.P. § 2143.03, pg. 2100-133 (Rev. 2, May 2004). Applicants submit that Claim 1 includes limitations which are not taught or suggested by the combination of Schein and Yuen, so Claim 1 is patentably distinguished over the prior art. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of Claim 1 and pass Claim 1 to allowance.

No motivation to combine

Applicants further submit that the Examiner has not presented a *prima facie* case of obviousness of Claim 1 because the Examiner has not provided a motivation in the prior art to combine Schein with Yuen.

The Examiner states that it would have been obvious to add the microprocessor of Yuen "to the VCR of the digital video recorder of Schein, in order, for example, to satisfy a design consideration, such as the processor in the VCR running the digital video recorder." The Examiner further states that it would have been obvious to one of ordinary skill in the art to incorporate the processor of Schein "into a variety of electronic devices to run those electronic

devices, such as the digital video recorder, in order to satisfy a desired design consideration, for example, control the set-top box."

However, Applicants submit that the fact that Yuen discloses a VCR containing a G-code decoding microprocessor does not itself provide a suggestion or motivation to move the microprocessor of Schein into the VCR of Yuen. Applicants further submit that Schein does not provide any motivation to move the microprocessor of Schein into the VCR. Therefore, neither of the cited references provides any motivation or suggestion for modifying Schein to include the teachings of Yuen, and the Examiner has not identified any other prior art reference for the motivation to combine Schein and Yuen.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000); M.P.E.P. § 2143.01, pg. 2100-130, (Rev. 2, May 2004). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. § 2143, pg. 2100-129 (2004).

The Examiner has stated only that the teachings of Schein and Yuen could be combined, but such statements do not establish a *prima facie* case of obviousness without any suggestion of desirability in the prior art. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); M.P.E.P. §2143.01, pg. 2100-131, (Rev. 2, May 2004).

As discussed in "Appellants' Brief pursuant to 37 C.F.R. § 1.192," the system recited by Claim 1 provides advantages not available from the disclosure of Schein by allowing relatively simple and inexpensive set-top boxes to be provided to all users, and only providing the storage device and the EPG system microprocessor to users who want these capabilities. Applicants submit that by stating that the motivation to combine Schein and Yuen is found in satisfying a design consideration, the Examiner has impermissibly used hindsight by relying on the design of the claimed invention for the motivation to combine Schein with Yuen. *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999).

For the foregoing reasons, Applicants submit that Claim 1 is patentably distinguished over the cited prior art. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of Claim 1 and to pass Claim 1 to allowance.

Claims 2-12

Claims 2, 4-6, and 10-11 each depend from Claim 1, Claim 3 depends from Claim 2, Claims 7-9 each depend from Claim 6, and Claim 12 depends from Claim 11. Each of Claims 2-12 includes all the limitations of Claim 1, as well as other limitations of particular utility. Therefore, Claims 2-12 are each patentably distinguished over the cited prior art. Applicants respectfully request that the Examiner withdraw the rejections of Claims 2-12 and pass these claims to allowance.

Claim 19

For reasons similar to those described above with respect to Claim 1, Applicants submit that Claim 19 includes limitations not taught or suggested by either Schein or Yuen and that there is no motivation to combine these two references. Applicants therefore submit that Claim 19 is patentably distinguished over the cited prior art. Applicants respectfully request that the Examiner withdraw the rejection of Claim 19 and pass Claim 19 to allowance.

Claims 22-30

As previously presented, independent Claim 22 recites (emphasis added):

> 22. A method for communicating electronic program guide information from a set-top box configured to receive the electronic program guide information to a digital video recorder comprising a video output interface connectable to a display device and a microprocessor configured to control the digital video recorder and the set-top box, the microprocessor comprising an electronic program guide subsystem, the method comprising:
>
> connecting at least one recorder interface of the digital video recorder to at least one auxiliary interface of the set-top box, **the recorder interface separate from the video output interface and connected to the electronic program guide subsystem;**
>
> recognizing the connection of the digital video recorder to the set-top box; and
>
> **communicating the electronic program guide information from the set-top box to the electronic program guide subsystem.**

For reasons similar to those described above with respect to Claim 1, Applicants submit that Claim 22 includes limitations not taught or suggested by either Schein or Yuen and that there is no motivation to combine these two references. Applicants therefore submit that Claim 22 is

patentably distinguished over the cited prior art. Applicants respectfully request that the Examiner withdraw the rejection of Claim 22 and pass Claim 22 to allowance.

Each of Claims 23, 26, 27, and 30 depends from Claim 22, each of Claims 24 and 25 depends from Claim 23, and each of Claims 28 and 29 depends from Claim 27. Each of Claims 23-30 includes all the limitations of Claim 22, as well as other limitations of particular utility. Therefore, Claims 22-30 are each patentably distinguished over the cited prior art. Applicants respectfully request that the Examiner withdraw the rejections of Claims 22-30 and pass these claims to allowance.

Response to Rejection of Claims 13, 14, 16, and 17 Under 35 U.S.C. § 103(a)

In the August 31, 2005 Office Action, the Examiner rejects Claims 13, 14, 16, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Schein in view of Yuen and further in view of U.S. Patent No. 6,003,041 issued to Wugofski ("Wugofski").

As discussed above, the combination of Schein and Yuen does not disclose or suggest all the limitations of Claim 1, nor does the prior art provide a motivation to combine Schein with Yuen. Applicants submit that Wugofski does not disclose or suggest the missing limitations or provide the missing motivation to combine these references. Therefore, Applicants submit that Claim 1 is patentably distinguished over Schein in view of Yuen and further in view of Wugofski.

Each of Claims 13, 14, 16, and 17 depends from Claim 1, so each discloses all the limitations of Claim 1 as well as other limitations of particular utility. Therefore, Claims 13, 14, 16, and 17 are each patentably distinguished over the cited prior art. Applicants respectfully request that the Examiner withdraw the rejections of Claims 13, 14, 16, and 17 and pass these claims to allowance.

Response to Rejection of Claims 15 and 18 Under 35 U.S.C. § 103(a)

In the August 31, 2005 Office Action, the Examiner rejects Claims 15 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Schein in view of Yuen and further in view of U.S. Patent No. 5,963,264 issued to Jackson ("Jackson").

As discussed above, Schein in view of Yuen does not disclose or suggest all the limitations of Claim 1, nor does the prior art provide a motivation to combine Schein with Yuen. Applicants submit that Jackson does not disclose or suggest the missing limitations or provide

the missing motivation to combine these references. Therefore, Applicants submit that Claim 1 is patentably distinguished over Schein in view of Yuen and further in view of Jackson.

Each of Claims 15 and 18 depends from Claim 1, so each discloses all the limitations of Claim 1 as well as other limitations of particular utility. Therefore, Claims 15 and 18 are each patentably distinguished over the cited prior art. Applicants respectfully request that the Examiner withdraw the rejections of Claims 15 and 18 and pass these claims to allowance.

Response to Rejection of Claim 21 Under 35 U.S.C. § 103(a)

In the August 31, 2005 Office Action, the Examiner rejects Claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Schein in view of Yuen and further in view of U.S. Patent No. 5,699,107 issued to Lawler et al. ("Lawler").

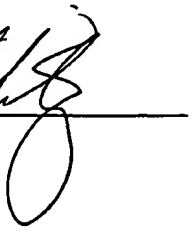
As discussed above, Schein in view of Yuen does not disclose or suggest all the limitations of Claim 19, nor does the prior art provide a motivation to combine Schein with Yuen. Applicants submit that Lawler does not disclose or suggest the missing limitations or provide the missing motivation to combine these references. Therefore, Applicants submit that Claim 19 is patentably distinguished over Schein in view of Yuen and further in view of Lawler.

Claim 21 depends from Claim 19, so Claim 21 discloses all the limitations of Claim 19 as well as other limitations of particular utility. Therefore, Claim 21 is patentably distinguished over the cited prior art. Applicants respectfully request that the Examiner withdraw the rejections of Claim 21 and pass Claim 21 to allowance.

Summary

In view of the foregoing remarks, Applicants submit that Claims 1-19 and 21-30 are in condition for allowance, and such action is respectfully requested.

Respectfully submitted,

Dated: 11/1/05 By: 

Bruce S. Itchkawitz
Registration No. 47,677
(949) 760-0404

1939340
110105

REMARKS

The foregoing amendments and the following remarks are responsive to the February 17, 2004 Office Action. Claims 1-19 and 21-30 are presented for further consideration. Please reconsider the claims in view of the following remarks.

Comments on Personal Interview of May 11, 2004

Applicants thank the Examiner Onuaku for extending the courtesy of scheduling a personal interview with Applicants' representatives, Bruce S. Itchkawitz and Jerry T. Sewell, for May 11, 2004. Applicants also thank Examiners Andrew Christensen and Vincent Boccio for allowing Mr. Itchkawitz and Mr. Sewell to meet with Examiner Boccio to discuss the present application when Examiner Onuaku was unable to attend. The remarks herein are in accordance with that discussion.

Response to Rejection of Claims 1-12, 19, and 22-30 Under 35 U.S.C. § 103(a)

In the February 17, 2004 Office Action, the Examiner rejects Claims 1-12, 19, and 22-30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,002,394 issued to Schein et al. ("Schein") in view of U.S. Patent No. 6,430,459 issued to Yuen et al. ("Yuen").

Applicants submit that Claim 1 includes limitations not taught or suggested by either Schein or Yuen. The Interview Summary prepared during the personal interview on May 11, 2004 indicates that Examiner Boccio agreed that the rejection applied to Claim 1 seems deficient, since "the combination applied fails to show or suggest control from the recorder controlling the set-top box and ... fails to disclose the EPG in the recorder." Applicants submit that Claim 1 is patentably distinguished over the cited prior art. Applicants respectfully request that the Examiner withdraw the rejection of Claim 1 and pass Claim 1 to allowance.

Claims 2, 4-6, and 10-11 each depend from Claim 1, Claim 3 depends from Claim 2, Claims 7-9 each depend from Claim 6, and Claim 12 depends from Claim 11. Each of Claims 2-12 includes all the limitations of Claim 1, as well as other limitations of particular utility. Therefore, Claims 2-12 are each patentably distinguished over the cited prior art. Applicants respectfully request that the Examiner withdraw the rejections of Claims 2-12 and pass these claims to allowance.

As described above with respect to Claim 1, Applicants submit that Claim 19 includes limitations not taught or suggested by either Schein or Yuen. Applicants therefore submit that

Claim 19 is patentably distinguished over the cited prior art. Applicants respectfully request that the Examiner withdraw the rejection of Claim 19 and pass Claim 19 to allowance.

As described above with respect to Claim 1, Applicants submit that Claim 22 includes limitations not taught or suggested by either Schein or Yuen. Applicants therefore submit that Claim 22 is patentably distinguished over the cited prior art. Applicants respectfully request that the Examiner withdraw the rejection of Claim 22 and pass Claim 22 to allowance.

Each of Claims 23, 26, 27, and 30 depends from Claim 22, each of Claims 24 and 25 depends from Claim 23, and each of Claims 28 and 29 depends from Claim 27. Each of Claims 23-30 includes all the limitations of Claim 22, as well as other limitations of particular utility. Therefore, Claims 22-30 are each patentably distinguished over the cited prior art. Applicants respectfully request that the Examiner withdraw the rejections of Claims 22-30 and pass these claims to allowance.

Response to Rejection of Claims 13, 14, 16, and 17 Under 35 U.S.C. § 103(a)

In the February 17, 2004 Office Action, the Examiner rejects Claims 13, 14, 16, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Schein in view of Yuen and further in view of U.S. Patent No. 6,003,041 issued to Wugofski ("Wugofski").

As discussed above, Schein in view of Yuen does not disclose or suggest all the limitations of Claim 1. Applicants submit that Wugofski does not disclose or suggest the missing limitations. Therefore, Applicants submit that Claim 1 is patentably distinguished over Schein in view of Yuen and further in view of Wugofski.

Each of Claims 13, 14, 16, and 17 depends from Claim 1, so each discloses all the limitations of Claim 1 as well as other limitations of particular utility. Therefore, Claims 13, 14, 16, and 17 are each patentably distinguished over the cited prior art. Applicants respectfully request that the Examiner withdraw the rejections of Claims 13, 14, 16, and 17 and pass these claims to allowance.

Response to Rejection of Claims 15 and 18 Under 35 U.S.C. § 103(a)

In the February 17, 2004 Office Action, the Examiner rejects Claims 15 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Schein in view of Yuen and further in view of U.S. Patent No. 5,963,264 issued to Jackson ("Jackson").

As discussed above, Schein in view of Yuen does not disclose or suggest all the limitations of Claim 1. Applicants submit that Jackson does not disclose or suggest the missing

limitations. Therefore, Applicants submit that Claim 1 is patentably distinguished over Schein in view of Yuen and further in view of Jackson.

Each of Claims 15 and 18 depends from Claim 1, so each discloses all the limitations of Claim 1 as well as other limitations of particular utility. Therefore, Claims 15 and 18 are each patentably distinguished over the cited prior art. Applicants respectfully request that the Examiner withdraw the rejections of Claims 15 and 18 and pass these claims to allowance.

Response to Rejection of Claim 21 Under 35 U.S.C. § 103(a)

In the February 17, 2004 Office Action, the Examiner rejects Claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Schein in view of Yuen and further in view of U.S. Patent No. 5,699,107 issued to Lawler et al. ("Lawler").

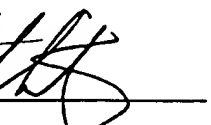
As discussed above, Schein in view of Yuen does not disclose or suggest all the limitations of Claim 19. Applicants submit that Lawler does not disclose or suggest the missing limitations. Therefore, Applicants submit that Claim 19 is patentably distinguished over Schein in view of Yuen and further in view of Lawler.

Claim 21 depends from Claim 19, so Claim 21 discloses all the limitations of Claim 19 as well as other limitations of particular utility. Therefore, Claim 21 is patentably distinguished over the cited prior art. Applicants respectfully request that the Examiner withdraw the rejections of Claim 21 and pass Claim 21 to allowance.

Summary

In view of the foregoing remarks, Applicants submit that Claims 1-19 and 21-30 are in condition for allowance, and such action is respectfully requested.

Respectfully submitted,

Dated: 5/28/04 By: 

Bruce S. Itchkawitz
Registration No. 47,677
KNOBBE, MARTENS, OLSON & BEAR, LLP
Attorney of Record
2040 Main Street
Fourteenth Floor
Irvine, CA 92614
(949) 760-0404